

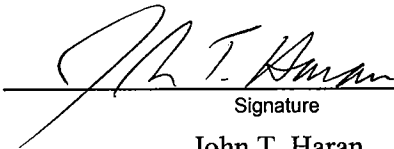
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		1487.0330000/DKSC/DRB	
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	10/021,249		December 19, 2001
	First Named Inventor		
	Eyal Trachtman		
	Art Unit	Examiner	
	2614	Melur Ramakrishnaiah	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
I am the			
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		John T. Haran	
<input type="checkbox"/> attorney or agent of record. Registration number _____		Typed or printed name	
<input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 <u>58,010</u>		(202) 371-2600	
		Telephone number	
		<u>January 5, 2007</u>	
		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Trachtman *et al.*

Appl. No.: 10/021,249

Filed: December 19, 2001

For: **System and Method for Providing
Broadcast Signals to Aircraft**

Confirmation No.: 7208

Art Unit: 2614

Examiner: Melur Ramakrishnaiah

Atty. Docket: 1487.0330000/DKSC/DRB

Arguments to Accompany the Pre-Appeal Brief Request for Review

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby submit the following Arguments, in five (5) or less total pages, as an attachment to the Pre-Appeal Brief Request for Review (Form PTO/SB/33). A Notice of Appeal is concurrently filed.

Summary of Request

The Examiner's combination of U.S. Patent No. 6,741,841 to Mitchell ("the Mitchell patent") and U.S. Patent No. 6,522,865 to Otten ("the Otten patent") is improper. The Examiner has failed to establish a *prima facie* case of obviousness based upon these references. Without more evidence of unpatentability, Applicants are entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Arguments

The Examiner has rejected claims 1, 3-21, 23, and 24 under 35 U.S.C. §103(a) for allegedly being unpatentable over the Mitchell patent in view of the Otten patent.

Each of the claims of the present application requires separating or a device for separating broadcast data from other data (e.g. communications data). Independent claim 1 is directed to an apparatus for receiving signals transmitted by a satellite and recites, "the apparatus further includes a frequency splitter for separating said communications channels from said broadcast channels." Independent claim 11 is directed to a system for providing broadcasts to aircraft and recites, "decoding means acting to separate the broadcast signals from the communication signals." Independent claim 20 is directed to an apparatus for receiving real-time broadcasts on aircraft and recites, "decoding means for separating broadcast data from other data contained within a signal received on-board the aircraft." Independent claim 21 is directed to a method of providing real-time broadcasts to an aircraft and recites, "separating the broadcast data from the communication data."

The Examiner admits that the Mitchell patent does not disclose this feature of the present invention. (Office Action mailed 10/5/06 at p. 4). Further, the Examiner provides no suggestion or motivation, other than impermissible hindsight based on Applicants' disclosure, to modify the system disclosed in the Mitchell patent to arrive at the claimed invention.

The Mitchell patent appears to disclose a communication system that is capable of receiving television programming signals and Internet communications. The system receives RF signals containing both television programming signals and Internet communications in the 11.70 to 12.75 GHz band and down converts them to IF signals in the 950 to 1450 MHz band, which is commonly referred to as L-band. See col. 25, lines 1-10. Splitter 460 receives the L-band IF signals and the output is fed to DBS receiver 264 and to receiver 413 such that "the split L-band IF outputs contain both television

programming signals and Internet communications." See col. 25, lines 59-67. In this regard, the "splitter" disclosed in the Mitchell patent is not capable of separating television programming signals and Internet service signals. Rather, the Mitchell patent discloses that the same signal is present at all outputs of the "splitter."

The Examiner alleges that it would have been obvious to one of ordinary skill in the art to modify Mitchell's system to include a splitter of the type disclosed by Otten. However, the Examiner has provided no suggestion or motivation, other than impermissible hindsight based on Applicants' disclosure, to modify the system disclosed in the Mitchell patent to arrive at the claimed invention. Firstly, Mitchell does not contain any teaching that would have motivated the skilled person to have tried to separate the television programming signals from the Internet signals. Mitchell teaches that each of the Internet receiver (item 364 in Fig. 11) and the television receiver (item 413 in Fig. 13) receives both television programming signals and Internet service signals (see Fig. 13 in combination with column 25, lines 66 and 67). Mitchell does not teach that there is any disadvantage associated with providing Internet signals to the television receiver, or with providing television signals to the Internet receiver. Thus, given that Mitchell does not acknowledge the existence of any problems that arise when both television and Internet signals are provided to each receiver, the skilled person would have had no motivation to try to separate the signals. Further, it is not even apparent that Otten's splitter would be compatible with Mitchell's system. Given that neither reference discloses how television signals are combined with Internet signals, and the wide range of possibilities available (for example, frequency division multiple access, spread spectrum multiple access or time division multiple access) one cannot assume that

Otten's splitter would have been capable of separating the signals present in Mitchell's system.

For at least these reasons, independent claims 1, 11, 20, and 21 are patentable and allowance thereof is respectfully requested. Dependent claims 3-10, 23, and 24 depend from and add further features to independent claim 1 and are thus patentable for at least the same reasons as claim 1. Dependent claims 12-19 depend from and add further features to independent claim 11 and are thus patentable for at least the same reasons as claim 11.

Additionally, with regard to independent claims 1 and 20, even if one of ordinary skill in the art were to have sought to separate the television programming signals from the Internet communications of the Mitchell patent, the Otten patent does not provide any motivation or suggestion to modify the system of the Mitchell patent to include a "frequency splitter" or decoding means for separating signals based on frequency, as recited in claims 1 and 20, respectively.

As noted above, Mitchell does not disclose how frequencies are allocated to the television programming signals and Internet service signals. In the absence of any disclosure that the television signals are separate in frequency from the Internet signals, one cannot infer that it would have been possible to have separated these signals by means of a frequency splitter. Further, Otten discloses a splitter that is capable of separating television signals from Internet signals (see column 8, lines 6 to 14), but does not disclose that this is a frequency splitter or that television signals are separate in frequency from Internet signals. Thus, Otten does not explicitly or implicitly disclose that the splitter is a frequency splitter (i.e. a splitter that is capable of separating television signals from Internet signals according to their respective frequencies).

Otten's splitter might equally use some other means to separate the signals, such as spread spectrum multiple access or time division multiple access. Thus, even if the skilled person were to have incorporated Otten's splitter into Mitchell's system, he would not inevitably have arrived at a system comprising a frequency splitter as defined by the claims.

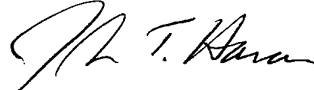
Conclusion

Applicants respectfully submit that the Examiner's combination of references is improper and claims 1, 3-21, and 23-24 are patentable over the cited art. Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration of Applicants' Pre-Appeal Brief Request for Review is respectfully requested.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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Date: January 5, 2007

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